REMARKS

In the final Office Action, the Examiner rejected claims 1-7, 11-15, and 19 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,803,579 issued to Turnbull et al. The Examiner further indicated that claims 8-10 and 16-18 would be allowed if rewritten in independent form. Applicant wishes to thank the Examiner for this indication of allowable subject matter.

With the prior response, Applicant antedated the Turnbull et al. reference by submitting a Declaration under 35 C.F.R. §1.131 executed by the inventor, John Roberts. In the Declaration, Mr. Roberts declared he is "*the* inventor of all the claims of the present patent application." Mr. Roberts further declared that as of June 13, 1996 he had constructively reduced to practice the invention as defined in claims 1-19 of the present application.

In the final Office Action, the Examiner contends that Applicant's argument that the Turnbull et al. reference was not available as prior art is unpersuasive. The Examiner contends that the reference is available as prior art under 35 U.S.C. §102(e) because the invention was described in a patent granted on an application for patent by another filed in the United States before the invention by the Applicant for patent. However, for a reference to qualify as prior art under 35 U.S.C. §102(e), the reference must both be by another, and be filed in the United States before the invention by the Applicant for patent. Because the Declaration under 37 C.F.R. §1.131 indisputably states that John Roberts had constructively reduced the invention to practice as of June 13, 1996, and because the Turnbull et al. reference was not filed ***before*** the June 13, 1996 invention date, the Turnbull et al. reference is not available as prior art under §102(e) and the rejection based on Turnbull et al. should be withdrawn.

On February 28, 2006, Applicant's representative called the Examiner to discuss the alleged deficiency of Applicant's arguments. The Examiner referred the undersigned to two sections of the MPEP, namely MPEP §706.2(b) and §2136.05. Applicant's representative has reviewed these sections and respectfully submits that they do not suggest in any way that such a rejection under §102(e) cannot be overcome by filing a Declaration under 37 C.F.R. §1.131. In fact, MPEP §2136.05 expressly states that a §102(e) rejection can be overcome by

antedating the filing date of the reference by submitting an affidavit or declaration under 37 C.F.R. §1.131. Furthermore, it should be noted that MPEP §715.01(c) states that a Declaration under 37 C.F.R. §1.131 may be effective to overcome a rejection over a published reference even if the Applicant is one of the co-authors of the publication. MPEP §716.10 also provides an example of a situation when subject matter disclosed but not claimed in a patent application filed jointly by an inventor S and another, is claimed in a later application filed by S. In this case, the joint patent or joint patent application publication is a valid reference available as prior art under §102(e) "unless overcome by affidavit or declaration under 37 C.F.R. §1.131 showing prior invention."

For the reasons stated above, Applicant respectfully submits that the fact that John Roberts is also a listed inventor of the Turnbull et al. reference does not preclude the filing of a Declaration under 37 C.F.R. §1.131 to antedate the reference.

Applicants further wish to point out to the Examiner that the inventorship listed in both the present application and the Turnbull et al. reference is indeed correct. First, as pointed out in MPEP §2137.01, subsection I, "the party or parties executing an oath or declaration under 37 C.F.R. 1.63 are presumed to be the inventors." Further, §706.2(g) states "the Examiner must presume the applicants are the proper inventors unless there is proof that another made the invention and that applicant derived the invention from the true inventor."

Applicant respectfully submits that the inventorships of the present application and the Turnbull et al. patent are correct and that there is no basis for the Examiner to conclude otherwise. Moreover, Applicant submits that the Declaration under 37 C.F.R. §1.131 is sufficient to overcome the only grounds of rejection.

During a subsequent telephone call on March 2, 2006, the Examiner mentioned that due to the overlapping claim scope of this application and the Turnbull et al. patent, Applicant should present a statement to the effect that the two additional inventors (Robert Turnbull and Robert Knapp) did not contribute to the invention of the subject matter commonly claimed. Accordingly, Applicant's representative investigated the issue and confirms that John Roberts is the sole inventor of the claimed subject matter of this application and that both Robert

Turnbull and Robert Knapp contributed to other subject matter disclosed and claimed in the Turnbull et al. patent. In particular, Robert Turnbull and Robert Knapp did not contribute to the idea of configuring a surface of an encapsulant to define an optical lens that either includes a plurality of concentric circular grooves or is a divergent lens.

For the reasons stated above, Applicant respectfully requests the Examiner's reconsideration and timely allowance of the claims. A Notice of Allowance is therefore respectfully solicited.

Please charge any additional fees or credit overpayment to Deposit Account No. 16-2463. A duplicate copy of this sheet is attached.

Respectfully submitted,

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